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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

MARCANTONI, PAUL D

ART UNIT

PAPER NUMBER

1755

DATE MAILED: 07/12/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/753,089

Applicant(s)

LUO ET AL.

Examiner

Paul Marcantoni

Art Unit

1755

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 June 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-11 and 18-27 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3-11, and 18-27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

The applicants' amendment and response submitted 6/5/06 has been considered but is not persuasive.

ODP Rejection:

Claims 1 and 3-11 and 18-27 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over all claims of U.S. Patent No. 6,506,248 B1 (Duselis et al.) and 6,346,146 B1. Although the conflicting claims are not identical, they are not patentably distinct from each other because both teach a cement composite comprising a mixture of both bleached cellulose fibers and unbleached cellulose fibers.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A **timely** filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

35 USC 102/103:

Claims 1 and 3-11 and 18-27 are rejected under 35 USC 102 (a,b, and e) as anticipated by, or in the alternative, under 35 USC 103(a) as obvious over Gregerson et al. (EP 263723-abstract only), Mai et al. (Journal of Mat'l Science-abstract only), and Mai et al. (Journal of Mat'ls Science-abstract only and different article from first Mai citation), Cook et al. '726 B2, Dezutter et al. '217 A1 or '452 B2, or Duselis et al. '248 B1 or '146 B1.

Response:

The applicants point out that the Obviousness Type Double Patenting is improper because only the claims may be considered. The examiner agrees that the ODP references must teach applicants' invention in their claims and the references he uses does just that. Applicants are referred to claim 40 of the '248 B1 and claim 58 in column 19 of the '146 patent.

The applicants argue that their claim limitations (e.g. claim 1) require 'wherein the bleached cellulose fibers comprise less than 50% of the total cellulose fibers incorporated into the matrix'. In rebuttal, less than 50% bleached cellulose fibers reads upon zero percent or no bleached fibers because less than language includes zero as a lower limit. Further, these ODP references teach a mixture of bleached cellulose fibers and unbleached fibers and these references do not limit their invention to any particular range. It could be implied from this reference that any weight percent mixture of unbleached cellulose fibers/bleached cellulose fibers from zero to 100 wt% for each

component is within the teaching of "and mixtures thereof" as set forth in these ODP references' claims.

The applicants also argue claim 18 with reference to a term that is an indefinite term. "Pre-determined" is indefinite. Are applicants actually suggesting that because the prior art does not allegedly teach a "pre-determined" flexibility and strength that their invention is different over the prior art? Is there ever a situation wherein one of ordinary skill in the art does not *predetermine* the properties he or she wishes in a final product or do they blindly dive into a process without any notion of the end result or the properties predetermined or desired? Most processes if not almost all processes "predetermine" the properties desired in the final product. It is evident "predetermined" is not only a known indefinite term but a term that plainly shows no patentable distinction over any prior art reference.

The applicants also argue Kappa number with reference to claim 25 noting cellulose fibers of Kappa number less than or equal to 10 and cellulose fibers having Kappa number greater than 10. The Kappa number property would appear to refer to bleached fibers and unbleached fibers in claim 25 and this is still within the teaching of the ODP references.

The applicants argue Gregerson in terms of the EP Patent. It would appear that applicants have this document but did not submit it. It is respectfully requested this document be submitted if applicants have it in their possession so it can be electronically scanned into the prosecution record. The applicants argue that Gregerson does not teach a greater amount of unbleached fibers than bleached

Art Unit: 1755

cellulose fibers. In rebuttal, this is not exactly what applicants claim especially in claims such as claim 1. The applicants' limitation "less than 50% bleached cellulose fibers" reads upon zero weight percent or no bleached cellulose fibers.

Mai abstracts do not appear to limit the amounts of bleached cellulose fibers and unbleached cellulose fibers in a cement composite. The applicants also argue that Mai teaches away from their invention because it imparts superior resistance to crack growth (ie fracture toughness). In rebuttal, the applicants do not present any properties of crack growth resistance or fracture toughness and it is improper for applicants to argue limitations not in their own claims.

The applicants argue Cook's "preferred embodiments" instead of considering the reference teachings as a whole. In rebuttal, a reference is good for all that it realistically teaches and is not limited to its preferred embodiments. The applicants also argue that Cook teaches away from adding bleached fibers to a cement composite. The examiner disagrees with this assertion and the claims of Cook teach that bleached fibers added to cement are within the teaching of this reference. The applicant then assert that there is no teaching of a "mixture" of both bleached and unbleached cellulose fibers. The examiner disagrees because Cook teaches that both bleached fibers and unbleached or untreated fibers can be blended or combined as a mixture. Cook even teaches the addition of fibers of bamboo, cotton, jute, and wood which are all untreated cellulose fibers (see col.10, lines 45-60).

The applicants also argue that Dezutter references may teach a mixture of bleached cellulose fibers and unbleached cellulose fibers wherein bleached cellulose

Art Unit: 1755

comprise less than 50% (it is assumed applicants mean weight percent?) of the total cellulose fibers in the cement matrix. In rebuttal, "less than 50% bleached cellulose fibers" reads upon no bleached cellulose fibers in the cement matrix. Nevertheless, Dezutter does not limit the amount of unbleached/bleached cellulose fibers to any particular range and it can be implied that any amount from zero to 100 wt% for each type of fiber in a mixture may be added to a cement matrix absent a showing of criticality or unexpected result from applicants specific mixture of bleached/unbleached cellulose fibers in a cement matrix.

For the above reasons, the rejections are sustained and the finality of this office action is now proper. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul Marcantoni whose telephone number is 571-272-1373. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Paul Marcantoni
Primary Examiner
Art Unit 1755